

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte QIN LIU, CHARLES C. HALUZAK, MARZIO LEBAN,
LAWRENCE R. PLOTKIN, AND KENNETH E. TRUEBA

Appeal 2006-2320
Application 10/061,830
Technology Center 1700

Decided: October 27, 2006

Before WARREN, WALTZ, and TIMM, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

We remand the Application to the Examiner for consideration and explanation of issues raised by the record. 37 C.F.R. § 41.50(a)(1) (2006); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 3, August 2005).

The record shows that the Examiner objects to the Amendment filed January 11, 2005, as introducing new matter under 35 U.S.C. § 132 (Answer 3). The Examiner identifies the “added material” but does not state where in said Amendment the same appears (*id.*). We note that Appellants amended the paragraph at page 5, ll. 1-10, of the Specification to remove the language that the Examiner holds objectionable (Amendment filed on January 11, 2005, page 2).

Accordingly, the Examiner is required to identify the location of the objectionable language either in the Amendment filed January 11, 2005, or elsewhere in the Specification.

We copy appealed independent claim 8, dependent claim 9, and independent claim 20 as they appear in the Claims Appendix to the Brief:

8. A fuel cell system, comprising:

a fuel cell stack including at least one anode pair arranged such that the anodes within the anode pair face one another and define a fuel passage therebetween that extends from one anode in the pair to the other anode in the pair; and

fuel supply means for supplying a plurality of droplets to the fuel passage between the at least one anode pair.

9. A fuel cell system as claimed in claim 8, further comprising:

storage means for storing energy generated with fuel that is on the anodes when the system is shut down.

20. A fuel supply system for use with a fuel cell including an anode, comprising:

a fuel reservoir that stores fuel;

fuel supply means, operably connected to the fuel reservoir, for supplying a plurality of droplets to the at least one anode; and

a controller adapted to monitor a rate of fuel consumption at the anode and to control the fuel supply means to supply droplets at a rate that results in a fuel layer being maintained on the anode.

The resolution of the principal issues in the grounds of rejection involving these three claims under 35 U.S.C. §§ 102(b) and 103(a) advanced on appeal requires that the subject claim language must first be interpreted by giving the claim terms their broadest reasonable interpretation consistent with the written description provided in Appellants' Specification as it would be interpreted by one of ordinary skill in this art. *See In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997) ("[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification."); *In re Donaldson Co.*, 16 F.3d 1189, 1192-95, 29 USPQ2d 1845, 1848-50 (Fed. Cir. 1994) (*en banc*) ("[T]he 'broadest reasonable interpretation' that an examiner may give means-plus-function language is that statutorily mandated in [35 U.S.C. § 112,] paragraph six."); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. When the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art. *See In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).").

In view of the “means” recitations which specify the function but do not define structure which satisfies that function in appealed claims 8, 9, and 20, the strictures of 35 U. S. C. § 112, sixth paragraph, apply. *See Texas Digital Systems, Inc. v. Telegenx, Inc.*, 308 F.3d 1193, 1208, 64 USPQ2d 1812, 1822-23 (Fed. Cir 2002), and cases cited therein. Therefore, all of the “means” language in these appealed claims must be construed as limited to the “corresponding structure” disclosed in the written description in the Specification and “equivalents” thereof. *Donaldson*, 16 F.3d at 192-95, 29 USPQ2d at 1848-50.

The “corresponding structure” is that “structure in the written description necessary to perform that function [citation omitted],” that is, “‘the specification . . . clearly links or associates that structure to the function recited in the claims.’ [Citation omitted.]” *Texas Digital Systems*, 308 F.3d at 1208, 64 USPQ2d at 1822-23. “[A] section 112, paragraph 6 ‘equivalent[]’ . . . [must] (1) perform the identical function and (2) be otherwise insubstantially different with respect to structure. [Citations omitted.]” *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 1364, 54 USPQ2d 1308, 1315-16 (Fed. Cir. 2000). “[T]wo structures may be ‘equivalent’ for purposes of section 112, paragraph 6 if they perform the identical function, in substantially the same way, with substantially the same result. [Citations omitted.]” *Kemco Sales*, 208 F.3d at 1364, 54 USPQ2d at 1315. “[T]he ‘broadest reasonable interpretation’ that an examiner may give means-plus-function language is that statutorily mandated in [35 U.S.C. § 112,] paragraph six,” and in this respect, the examiner should not confuse “impermissibly imputing limitations from the specification into

a claim with properly referring to the specification to determine the meaning of a particular word or phrase in a claim. [Citations omitted.]” *Donaldson*, 16 F.3d at 1195, 29 USPQ2d at 1850; *see also Morris*, 127 F.3d 1048, 1055-56, 44 USPQ2d 1023, 1028 (explaining *Donaldson*).

Thus, the Examiner must first interpret the “means for” claim language in order to establish a *prima facie* case of anticipation and of obviousness over the applied prior art because all of the claim limitations must be considered. *See, e.g., In re Geerdes*, 491 F.2d 1260, 1262-63, 180 USPQ 789, 791-92 (CCPA 1974) (In considering grounds of rejection “every limitation in the claim must be given effect rather than considering one in isolation from the others.”); *cf. Donaldson*, 16 F.3d at 1195-97, 29 USPQ2d at 1850-52.

Here, the Examiner has not interpreted the “means” language in appealed claims 8, 9, and 20 with respect to the “corresponding structure” in the Specification and “equivalents” thereof in a manner consistent with the requirements of 35 U. S. C. § 112, sixth paragraph (Answer 4-6 and 8).

Accordingly, the Examiner is required to take appropriate action consistent with current examining practice and procedure to interpret the “means” limitations of appealed claims 8, 9, and 20 by first determining the “corresponding structure” for the “function” in the limitation that is described in the Specification in a manner consistent with the requirements of 35 U.S.C. § 112, sixth paragraph, then determining whether the corresponding structure or “equivalents” thereof are taught or suggested by the applied prior art, and if so, setting forth the interpretations, findings, and determinations in a supplemental

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examiner's answer with a view toward placing this Application in condition for decision on appeal with respect to the issues presented.

This Remand is made for the purpose of directing the Examiner to further consider the grounds of rejection. Accordingly, if the Examiner submits a supplemental answer to the Board in response to this Remand, "appellant must within two months from the date of the supplemental examiner's answer exercise one of" the two options set forth in 37 C.F.R. § 41.50(a)(2) (2006), "in order to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding," as provided in this rule.

We hereby remand this Application to the Examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

REMANDED

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